



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No: 09/627,796 Confirmation No. 3581  
 Date Filed: July 28, 2000  
 Application Title: Non-Nucleic Acid Probes, Probe Sets, Method and Kits  
 Pertaining To The Detection Of Human Chromosomes X, Y,  
 1, 2, 3, 4, 6, 7, 8, 9, 10, 11, 12, 16, 17, 18 And 20 As Well As  
 13/21 As A Pair  
 Applicant: Krishan L. Taneja  
 Group Art Unit: 1634  
 Examiner: Jehanne Souaya Sitton  
 Action Date: January 29, 2004  
 Action Type: Second Office Action On Merits –Non-FINAL  
 Certified Mail No.: 7003 1680 0001 6779 2254

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**Certificate of Mailing Pursuant to:**  
**37 C.F.R. §1.8**

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 Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 28<sup>th</sup> day of July 2004.

Brian D. Gildea  
 Reg. No. 39,995

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**Petition Under 37 C.F.R. § 1.144 or 1.181**

Commissioner for Patents  
 Dear Sir or Madam:

Applicant hereby petitions for the withdrawal of the restriction requirement issued by the Examiner with an action dated September 21, 2001. Applicant did file a timely reply with traverse of the restriction requirement on January 18, 2002. Accordingly, please consider this petition.

In the restriction requirement, the Examiner takes the position that, with respect to claims 1-15, 21-23 and 29-45, a restriction requirement is proper in view of 35 U.S.C. § 121.

Applicant hereby respectfully traverses the present restriction requirement as being clearly contrary to the express holding of *In re Weber*. *In re Weber* holds that:

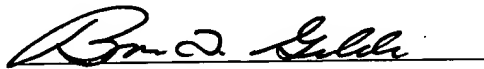
It is apparent that § 121 provides the Commissioner with the authority to promulgate rules designed to Restrict an Application to one of several claimed inventions when those inventions are found to be "independent and distinct". It does not, however, provide a basis to an examiner acting under the authority of the Commissioner to Reject a particular Claim on that same basis. *In re Weber*, 580 F.2d 455, 458, 198 U.S.P.Q. 328, \_\_ (CCPA, 1978)

**We hold that a rejection under § 121 violates the basic right of the applicant to claim his invention as he chooses** (emphasis added). *In re Weber*, 580 F.2d 455, 459, 198 U.S.P.Q. 328, \_\_ (CCPA, 1978)

Accordingly, it is clear from *In re Weber* that the legal issue of whether or not The Office may impose a restriction requirement to a **single claim** has been decided against The Office. It is well settled that such a requirement violates 35 U.S.C. 112, where the applicant is statutorily entitled to claim his invention as he deems proper, notwithstanding 35 U.S.C. § 121. This is true whether or not the inventions are determined by The Office to be independent and distinct.

Applicant further notes that with each Group that the Examiner argues is a separate invention (i.e. Groups I-XVIII), they are each similarly classified in Class 536, subclass 23.1 and Class 435, subclass 6. Thus, for purposes of a search, there is no additional burden placed upon The Office since the same class and subclasses must be searched, and no additional Class or subclass must be searched, whether or not the restriction requirement is imposed.

Additionally, Applicants take the position that said claims are generic and use proper Markush format. Accordingly, Applicant takes the position that the present restriction requirement is improper and therefore requests that it be withdrawn.

  
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